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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,824	09/27/2001	Leslie Graf	027566-030	9537
27045	7590	04/05/2005	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			NGUYEN, BINH QUOC	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/831,824	GRAF ET AL.	
	Examiner	Art Unit	
	Binh Q. Nguyen	2664	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/27/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claims 1 and 3** are objected to because of the following informalities:

a) Claim 1: Term “ISUP” in line 2 is improper because it’s not spelled out completely for at least one time.

Examiner suggests changing this term to “Integrated Services Digital Network User Part (ISUP)”.

b) Claim 3: Term “the subscriber parties” in lines 2-3 is improper because there is no antecedent basis.

Examiner suggests changing this term to “a subscriber parties”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 3 and 4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said connection" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over *MacMillan et al* (US Patent No. 6,278,707) in view of *Sayers et al* (US Patent No. 6,539,237) as applied to claim 1-5 above, and further in view of *International Telecommunication Union Q.737(3/93)*.

a) Regarding to Claim 1, 2, and 5: *MacMillan et al* discloses a method and apparatus for communicating signalling data between a pair of telecommunication switches (*see Fig. 7*) employing ISUP signaling, via a packet switched data network, the method comprising (*see Fig.4 and Fig.7*) means for using H.323 protocol to communicate over the data network where signalling data is carried by a Q.931 based protocol (*see col.7, lines 33-46, col.8 lines 59-67*).

MacMillan et al fails to explicitly disclose the ISUP Network Discard Indicator message or the extended Q.931 being applied to H.323 protocol.

However, *International Telecommunication Union* publication explicitly discloses such a discard message (*see Section 1.1.5.2.5.2.3, lines 1-4*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement such H.323 protocol to communicate over the data network where signalling data is carried by a Q.931 based protocol and the ISUP Network Discard Indicator message, as taught by *MacMillan*, modified by the *International Telecommunication Union* publication since *MacMillan* suggests extending Q.931 beyond the standard to met the need of H.323 including continuity testing and management messaging (*see col.8 lines 59-67*).

- b) Regarding claims 3 and:** *MacMillan et al* discloses IP, Telephony, hence part or all of the connection utilizes a TCP/IP network (*see col. 3 lines 18-28, and col. 7 lines 32-46*).
- c) Respect claim 4,** *MacMillan et al* use of H.323 over the Internet and hence the use of TCP/IP protocol stack (*see col. 7 lines 32-46*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh Q. Nguyen whose telephone number is 571-272-8563. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2664

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Respectfully submitted,

By: 

Binh Q. Nguyen

Patent Examiner

04/01/2005


WELLINGTON CHIN
SENIOR PATENT EXAMINER